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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,168	12/22/2003	Ulrich Schiestl	DT-6691	7758
30377	7590	02/09/2005	EXAMINER	
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			LOPEZ, MICHELLE	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/743,168

Applicant(s)

SCHIESTL ET AL.

Examiner

Michelle Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to the amendment filed on November 18, 2004.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,722,548 issued to Odoni et al. in view of Veldman. Although the conflicting claims are not identical, they are not patentably distinct from each other because application claim 1 merely adds a feature absent from Odoni's claim 1.

Application claim 1 recites a fuel source 11 with a fuel feed line 12 from the fuel source 11 to a combustion chamber 13 and having at least one dosing device 30 arranged between the fuel source 11 and the combustion chamber 13, wherein the dosing device 30 comprises a displacement body 50, 51 arranged in a chamber for forcing fuel out of the chamber 31, and wherein the displacement body 50, 51 has displacement volume that is adjustable.

It is clear that all the elements of application claim 1 are to be found in Odoni's claim 1, including a fuel source 11 with a fuel feed line 12 from the fuel source 11 to a combustion

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chamber 13; and at least one dosing device via 14 arranged between the fuel source 11 and the combustion chamber 13, but Odoni does not disclose that the dosing device via the mechanical controlled valve 14 has a displacement body arranged in a chamber for forcing fuel out of the chamber and that the displacement body has a displacement volume that is adjustable.

However, Veldman (5,00,128) teaches a portable power tool having a dosing device with a displacement body 32 arranged in a chamber 30 for the purpose of controlling and forcing fuel out of the dosing chamber 30 in a controlled manner, wherein the displacement body 32 has a displacement volume that is adjustable using a manually operated setting means 43 (see col. 3; 51-65, and col. 4; 50-65). In view of Veldman, it would have been obvious to one having ordinary skill in the art to have provided Odoni's invention with a dosing device having a displacement body arranged in a chamber in order to control and force the fuel out of the dosing chamber in a controlled manner, wherein the displacement body has a displacement volume that is adjustable using a manually operated setting means.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6-8, 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Veldman (5,000,128).

With respect to claim 1, Veldman discloses an internal combustion driven setting tool for driving fastener elements comprising a fuel source 5 with a fuel feed line from the fuel source to

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a combustion chamber 2 and having at least one dosing device 31 arranged between the fuel source 5 and the combustion chamber 2, wherein the dosing device 31 comprises a displacement body 32 arranged in a chamber 30 for forcing fuel out of the chamber 30, and wherein the displacement body 32 has displacement volume that is adjustable.

With respect to claim 2, Veldman discloses wherein the displacement volume of the displacement body 32 is adjustable via a control device 41,42.

With respect to claim 3, it is deemed that the displacement body 32 is adjustable using a manually operated setting means via 43.

With respect to claim 6, Veldman discloses wherein the chamber 30 has an inlet and an outlet and wherein valves 41,42 are arranged at the inlet and the outlet of the chamber 30 that make fuel transport possible only in the direction towards the combustion chamber 2.

With respect to claim 7, Veldman discloses wherein the displacement body is a piston via 37 that is displaceable guided in the chamber 30 and includes a piston stroke that defines the displacement volume.

With respect to claim 8, Veldman discloses wherein the displacement body is a membrane via 32 that closes an opening to a chamber media - tight and is moveable into the chamber 30 and wherein a membrane stroke defines the displacement volume.

With respect to claim 10, Veldman discloses wherein the displacement body can be mechanically actuated using an actuation means 22.

With respect to claim 11, Veldman discloses wherein the displacement body is excited using the control device 41,42.

***Conclusion***


4. Applicant's arguments, with respect to the rejection(s) of claim(s) 1-6 and 8-11 under 35 U.S.C. 103(a) as being unpatentable over Odoni in view of Veldman, and the rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Odoni in view of Veldman, and further in view of Achten have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,722,548 issued to Odoni et al., and under 35 U.S.C. 102(b) as being anticipated by Veldman (5,000,128).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOHN SIPOS  
PRIMARY EXAMINER